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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,119	12/03/2003	Denis Gravel	GOUD:045US	4417

7590

10/03/2005

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EXAMINER
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SOLOLA, TAOFIQ A

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/727,119

Applicant(s)

GRAVEL ET AL.

Examiner

Taofiq A. Solola

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 02 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 21-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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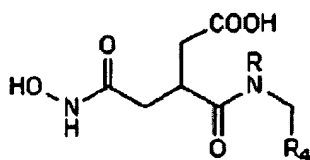
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Claims 1-33 are pending in this application.

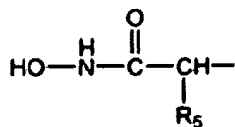
Claims 21-33 are drawn to non-elected invention.

**RESTRICTION REQUIREMENT**

In response to the Restriction Requirement, Applicant elects with traverse the invention of group I, claims 1-20. The traversal is on the basis that the Office has not shown it would be undue burden to examine all the groups. This is not persuasive for reasons set forth in the Restriction Requirement. Applicant also elects the following species:



wherein in formula I, R1 = R2 = R3 = R5 = H; A is



; B is absent; E is H; D is -COOH and v is 0.

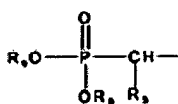
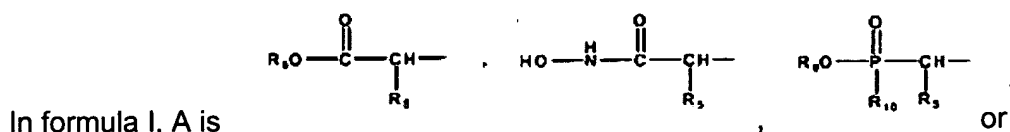
Therefore, claims 1-20 are being examined in part subject to the election made by applicant.

**Status of Claims**

The Office has reviewed the claims and disclosure to determine the scope of the independent invention encompassing the elected compound (compounds which are so similar thereto as to be within the same inventive concept and reduction to practice). The scope of an independent invention encompasses all compounds within the scope of the claims, which fall into the same class and subclass as the elected compound, but may include additional compounds, which fall in related subclasses. Examination of the elected compound AND the

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entire scope of the invention encompassing the elected compound as defined by common classification results in the following:



; E, R, R<sub>1</sub>, R<sub>3</sub>-R<sub>5</sub>, R<sub>8</sub>-R<sub>10</sub> are as defined in claim 1; D is -COOH; B is absent;

v is 0 and R<sub>2</sub>, R<sub>6</sub>-R<sub>7</sub> are not applicable. As a result of the election and the corresponding scope of the invention identified herein, the remaining subject matter of claims 1-20 are withdrawn from further consideration by the Examiner, under 37 CFR § 1.142(b), as being drawn to a non-elected subject matter. The withdrawn compounds are patentably distinct from the examined invention as they differ in structure and element and would require a separate search. In addition, a reference, which anticipates the examined invention, would not render obvious the non-examined subject matter.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The term "comprising", line 1, claim 1, renders claims 1-20 indefinite. It is an open-ended term, which cannot be used to describe a compound. By replacing it with "of" the rejection would be overcome.

Claim 16 is confusing and therefore indefinite. By using combination of colon and semicolon to separate the compounds the rejection may be overcome.

Claims 19-20 are multiple dependent claims but are not in the alternative. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 10-14, 16, 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Ondetti et al., US 4,113,715.

Ondetti et al., disclose generic compounds of formula (I) and several species and compositions thereof. See the abstract, columns 1-2, 5, the examples and the claims.

Claims 1, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Ovens et al., J. Peptide Sci. (2000), Vol. 6, No. 9, pages 489-495.

Ovens et al., disclose the marked compound on the attached abstract.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ovens et al., J. Peptide Sci. (2000), Vol. 6, No. 9, pages 489-495.

Applicant claims compositions of compound of formula I.

**Determination of the scope and content of the prior art (MPEP §2141.01)**

Ovens et al., teach the marked compound on the attached abstract and its method of use as inhibitor of procollagen C-protease.

**Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)**

The difference between the instant invention and that of Ovens et al., is that Applicant claims the compositions while Ovens et al., do not teach the composition.

**Finding of prima facie obviousness—rational and motivation (MPEP §2142.2413)**

However, for the compound to be used as inhibitor of procollagen C-protease it must be used in the form of a composition. Therefore, the instant invention is prima facie obvious from the teaching of Ovens et al. One of ordinary skill in the art would have known to claim the composition at the time the invention was made. The motivation is from the teaching of Ovens et al., that the compound is useful as inhibitor of procollagen C-protease.

***Allowable Subject Matter***

Claims 1-20 are objected to for containing non-elected subject matter. To place the application in condition for allowance, all claims drawn to non-elected subject matter must be cancelled and claims 1-20 must be amended within the scope of allowable subject matter set forth above under Status of Claims.

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***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

  
**TAOFIQ SOLOLA  
PRIMARY EXAMINER**

Group 1626

September 27, 2005